

REMARKS

This Amendment is submitted in reply to the non-final Office Action mailed on October 2, 2009. The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 3712036-00486 on the account statement.

Claims 1, 3-12 and 14-17 are pending in the application. Claims 2 and 13 were previously cancelled without prejudice or disclaimer. In the Office Action, Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. §112, first paragraph. Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. §112, second paragraph. Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. §103(a). In response, Applicants have amended Claims 1 and 12 and canceled Claims 5-8. The amendments do not add new matter and are supported in the specification at page 2, lines 5-6 and page 3, lines 3-8. In view of the amendments and for at least the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, Claims 1, 3-12 and 14-17 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement, and under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Patent Office asserts that the claim term "the milk product is room temperature stable for at least one month and is not cooled below room temperature to provide the foamed composition" is not enabled because the specification fails to provide specifics of storage temperature, thus failing to disclose what it means to be room temperature stable. See, Office Action, page 2, line 9 to page 3, line 7. The Patent Office asserts that this same claim term is indefinite because the term "stable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. See, Office Action, page 3, lines 8-23. In response, Applicants have amended both independent Claims 1 and 12 to remove reference to room temperature stability.

Therefore, Applicants respectfully submit that the present claims fulfill the requirements of 35 U.S.C. §112, first and second paragraphs. Accordingly, Applicants request that the enablement and indefiniteness rejections be withdrawn.

In the Office Action, Claims 1, 3-5, 7, 10-11, 15 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,107,343 to Petricca ("*Petricca*") in view of U.S. Patent No. 3,519,440 to Staackmann ("*Staackmann*"). Applicants respectfully submit, however, that (a) the cited references, alone or in combination, fail to disclose or suggest each element of the rejected claims and (b) the skilled artisan would have no reason to combine the cited references because the references teach away from each other and are directed toward products having completely different objectives.

Applicants submit that the cited references, alone or in combination, fail to disclose or suggest a milk product for providing at room temperature, either by shaking or with a foaming device, a foamed composition for beverages, the milk product comprising 0.3 to 3% propylene glycol monostearate by weight, 0.005 to 0.15% sorbitan tristearate by weight, and 0.005 to 0.015% unsaturated monoglyceride by weight as required, in part, by independent Claims 1 and 12. The Office Action admits that *Petricca* fails to disclose unsaturated monoglycerides and their amount in the composition. See, Office Action, page 7, lines 9-11.

Applicants submit, however, that *Staackmann* fails to remedy the deficiencies of *Petricca*. *Staackmann* discloses 0.1% of a mixture of mono and diglycerides. See, column 5, Composition A. The 0.1% level is clearly outside the range of unsaturated monoglycerides in the present claims. Even the Office Action asserts that *Staackmann* discloses "unsaturated monoglycerides and combinations thereof in the amount of 0.1%" by citing Composition A. Therefore, *Staackmann* fails to remedy the deficiencies of *Petricca*.

Further, Applicants respectfully submit that the skilled artisan would have no reason to combine the cited references because the references teach away from each other and are directed toward products having completely different objectives. For example, *Petricca* is entirely directed to a pourable, whippable, edible emulsion containing water, fat, sweetener, protein, thickener, buffer and emulsifiers. See, *Petricca*, Abstract. As a result, *Petricca* teaches a non-dairy (non-milk) emulsion. Each example and each formulation described in *Petricca* reinforces the non-dairy nature of the emulsion. See, column 2, Tables I and II, and columns 5-8, Examples 1-6. Though milk is mentioned in *Petricca*, it is only taught as a diluent for the finished product emulsion. Therefore, milk is not part of the emulsion invention of *Petricca*. Even the "disperable protein" of the emulsion is disclosed as sodium caseinate, which is a milk derivative

that is not a source of lactose and therefore an ingredient generally used in non-dairy products. In fact, Section 101.4(d) of Title 21 of the Code of Federal Regulations allows foods containing sodium caseinate to be labeled as non-dairy.

In contrast, *Staackmann* is entirely directed to providing a dairy product having storage stability and resistance to microbiological attack at room temperature. See, *Staackmann*, column 1, lines 49-68. Therefore, *Petricca* teaches essentially a non-dairy food product, which not only teaches away from *Staackmann*, but also teaches away from the present claims, which are directed to a milk product.

As such, the products and methods of the cited references explicitly teach away from the combination with each other and are directed toward products having completely unrelated objectives. Accordingly, the skilled artisan would have no reason to combine the cited references to arrive at the present claims. Indeed, it would be a stretch for the skilled artisan, aimed at providing a milk product (dairy product) as claimed, to arrive at such a result by reviewing *Petricca*, which is aimed solely at providing a non-dairy whippable emulsion, in view of *Staackmann*, which is directed to a dairy product. Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there exists no reason for the skilled artisan to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Applicants respectfully submit that what the Patent Office has done here is to apply hindsight reasoning by attempting to selectively piece together teachings of each of the references in an attempt to recreate what the claimed invention discloses. Applicants also submit that if it were proper for the Patent Office to combine any references to arrive at the present claims simply because each reference suggests an element of the present claims, then every invention would effectively be rendered obvious. Instead, the skilled artisan must have a reason to combine the cited references to arrive at the present claims. Applicants respectfully submit that such a reason is not present in the instant case.

Accordingly, Applicants submit that *Petricca* and *Staackmann*, alone or in combination, fail to disclose or suggest each element of the rejected claims and are not combinable because the references teach away from each other and are directed toward products having completely different objectives.

In the Office Action, Claims 6, 8 and 9 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Petricca* in view of *Staackmann* and further in view of U.S. Patent No. 4,199,608 to Gilmore et al. ("*Gilmore*"). Applicants respectfully submit that the patentability of independent Claim 1, established above, renders moot the obviousness rejection of Claims 6, 8 and 9, which depend from independent Claim 1.

In the Office Action, Claims 12, 14 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Petricca* in view of the combination of *Staackmann*, *Gilmore* and U.S. Patent No. 4,888,194 to Anderson et al. ("*Anderson*"). For the same reasons stated above with regard to independent Claim 1, *Petricca* and *Staackmann* both fail to disclose or suggest a milk product comprising 0.3 to 3% propylene glycol monostearate (PGMS) by weight, 0.005 to 0.15% sorbitan tristearate (STS) by weight, and 0.005 to 0.015% unsaturated monoglyceride by weight as required, in part, by independent Claim 12. Applicants submit that *Gilmore* and *Anderson* fail to remedy the deficiencies of *Petricca* and *Staackmann*.

The Office Action relies on *Gilmore* to teach the sorbitan tristearate levels of the present claims. See, Office Action, page 14, lines 2-18. Moreover, the monoglyceride levels taught in *Gilmore* are between 3% (Example 1) and 11.4 (Example 5), clearly exceeding the claimed range. See, *Gilmore*, Examples 1-7. The Office Action relies on *Anderson* to teach the method steps adding emulsifiers to skim milk and then adding cream as a source of fat to the emulsion. See, Office Action, page 15, line 10 to page 16, line 17. Moreover, *Anderson* teaches adding about 0.4% to about 1.0% by weight of an added monoglyceride emulsifier to the dairy product of *Anderson*. See, *Anderson*, Claim 1; column 2, lines 35-43; and column 3, lines 12-21. Like *Gilmore*, the monoglyceride levels taught in *Anderson* clearly exceeds the range of the present claims. Therefore, both *Gilmore* and *Anderson* fail to remedy the deficiencies of *Petricca* and *Staackmann*.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claim 1, 3-12 and 14-17 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic

interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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